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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Shelton Louie

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12/04/2007

IPSOLON, LLP (JRD)  
111 SW COLUMBIA ST.  
SUITE 710  
PORTLAND, OR 97201

EXAMINER

SHAAWAT, MUSSA A

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/829,536	<b>Applicant(s)</b> LOUIE ET AL.	
	<b>Examiner</b> Mussa A. Shaawat	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. This action is in response to the amendment filed on January 29, 2007. Claims 1, and 5 have been amended. Claims 7, 11 and 12 have been cancelled. 1-6, 8-10 and 13-20 are pending examination.

***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive.

In particular the applicant argues, A) No teaching or suggestion to group or bundle a customer's prescription orders together in a common carrier; B) No references of record teach or suggest electronic detection of prescription orders; C) Applicant contends that there is no motivation to combine references, D) Denenberg fails to provide a complete "chain of custody" of the filled prescription in storage and thereby fails to provide a fail-safe identification of which prescription is located in each location.

In response to A) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Denenberg et al., teaches grouping a plurality of prescription orders together in a common carrier (see for example the bag Fig. 5B; and col.10, lines 54-67). Therefore, Denenberg et al., still meet the scope of the limitation as currently claimed.

In response to B) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Denenberg in view of Engellenner shows a system for locating or detecting objects electronically, the objects include an electromagnetic tag instead of a bar code type tag which causes upon request from the controller, an interrogation signal to be transmitted from the specified

object (specified for example by a user), the signal for example includes the location of the object (it is transparent to one of ordinary skill in the art whether the electromagnetic tag is attached to prescription order or any other object), which is read as electronically detecting a prescription order. Furthermore, it would have been obvious to one of ordinary skill in the art to implement the location detection taught by Engellenner in a pharmacy environment taught by Denenberg. Therefore Denenberg in view of Engellenner still meet the scope of the limitation as currently claimed.

In response to C) applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be extremely advantageous to incorporate the teachings of Mccullough et al., into the discloser of Denenberg et al to make the system more efficient. Assigning a unique identification to the prescription, which is used to locate, the customers order and notify the customer of the order status (see Mccullough et al, col.3 lines 31-38, and col.6 line 53-col.7 line 25), one will be able to retrieve the prescription for the customer as quickly as possible. Therefore, in view of the above evidence, Mccullough and Denenberg et al., still meet the scope of the limitations as currently claimed.

In addition, KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at: <https://www.uspto.gov/web/offices/dcom/bpai/prec/fd071923.pdf>).

In response to D) applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing a complete "chain of custody" of the filled prescription in storage and thereby fails to provide a fail-safe identification of which prescription is located in each location) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6, 8-10 and 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 5 recite, "... without an affirmative tracking act by the pharmacy worker", examiner finds no support in applicants specification of the claimed feature without an affirmative tracking act by the pharmacy worker.

Claims 2-4, 6, 8-10 and 13-20 are rejected based on their dependency from rejected claims 1 and 5.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6, 8-10 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 5 recite, "... without an affirmative tracking act by the pharmacy worker", the recited renders the claims vague and indefinite.

Claims 2-4, 6, 8-10 and 13-20 are rejected based on their dependency from rejected claims 1 and 5.

Appropriate correction is required by applicant.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 8-10, and 13-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg US Pat. No. (6,464,142), in view of Mccullough et al., US Pat.No. (5,974,393), in further view of Markman US Pat. No. (5,794,213), in further view of Engellenner US Pat. NO. (6,057,756) cited in applicants specification as discussed in the previous office action. Further;

Denenberg fails to teach a tag having a unique identifier that is readable by a tag reader in proximity to the tag regardless of its orientation relative to the tag reader.

However Engellenner discloses an electromagnetic tag and tag reader (see col.7 lines 40-65, figure 1) for locating items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the tag and tag reader of Engellenner in Denenberg et al., because the tag reader of Engellenner can interrogate a larger spatial region.

Although Denenberg et al., teaches grouping a plurality of prescription orders together in a common carrier (see for example the bag Fig. 5B; and col. 10, lines 54-67). Denenberg fails to implicitly teach associating the unique identifier of the tag with customer information stored in a computer system in association with said group of prescription orders.

However, Markman teaches reforming grouped items that comprises the step of electronically bundling orders from a customer together and associates a unique identifier of the tag with customer information (see for example col.2 lines 52-67, and col.6 line 65-col.7 line 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Markman with the invention of Denenberg to electronically bundle orders from a customer together and associate a unique identifier of the tag with customer information to easily and efficiently identify the items of each customer.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al., Mccullough et al, Markman, and Engellenner et al as applied to claim 19 above, and further in view of Yehuda. Denenberg et al., Mccullough et al, Markman, and Engellenner et al teach all of the limitation of the claim except for a display of estimated completion. Yehuda discloses a display (16) that shows an estimated time until completion (see col. 4, lines 44-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Yehuda with the combination of Denenberg et al., Mccullough et al, Markman, and Engellenner et al. to help the customer quickly complete his transaction.



***Contact Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat  
Patent Examiner  
November 30, 2007

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627